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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/940,035	08/27/2001	Lane W. Lee	M-12040 US	4896
32605	7590	11/30/2005	EXAMINER	
MACPHERSON KWOK CHEN & HEID LLP			DINH, MINH	
1762 TECHNOLOGY DRIVE, SUITE 226			ART UNIT	
SAN JOSE, CA 95110			PAPER NUMBER	

2132

DATE MAILED: 11/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/940,035	<b>Applicant(s)</b> LEE ET AL.	
	<b>Examiner</b> Minh Dinh	<b>Art Unit</b> 2132	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 25 and 26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 25 and 26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. This action is in response to the amendment filed 09/15/2005. Claims 1-24 have been cancelled; claims 25-26 have been added.
2. The specification has been amended for pages 1-2; however, the same line number has been indicated for two separate replacement paragraphs on page 2 of the specification. Correction is required.

### ***Response to Arguments***

3. Applicant's arguments with respect to claims 25-26 have been considered but are not persuasive. Applicant's amendments have necessitated a new search and new grounds of rejection.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 25-26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to

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one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

- Regarding claim 25, it recites the limitation "a storage engine" (line 4); however, the word "engine" is used by itself in the originally filed specification and is defined as "the component that provides read and write access to digital media" (page 12, line 18) and can be implemented as firmware, software, hardware or any combination (page 14, lines 3-6). Since the originally filed specification does not disclose a storage engine, the limitation is considered new matter. Claim 26 is rejected on the same basis.
- Regarding claim 26, it recites the limitation "transmitting the secure session key from the host device to the storage engine to authenticate the host" (lines 11-12). The specification discloses the steps of generating and transmitting the session key to the host device (figures 6, 8, 16-17); however the specification does not disclose the step of "transmitting the secure session key from the host device to the storage engine to authenticate the host". Thus, the limitation is not supported by the originally file specification and is considered new matter.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 25 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 25 recites the limitation "the key complement" in lines

9-10. There is insufficient antecedent basis for this limitation in the claim. For examination purpose, the limitation is interpreted as "the complement key".

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Braitberg et al (6,631,359) in view of Sims, III (6,550,011). Braitberg discloses a method of unlocking a locked file stored in mastered pre-recorded portion on a storage medium, the file being encrypted according to a disk serial number/ID and a validation key, the disk serial number and the validation key being functionally equivalent to a content key and a complement key, the mastered pre-recorded portion including the disk serial number key but not the validation key, the storage medium also having an writeable area that is writable by a storage engine, the method comprising: receiving a request from a host device at the storage engine to unlock the locked file; providing the storage engine with the validation key; and writing the validation key to the writeable area to unlock the file. Braitberg does not disclose authenticating a host device and authenticating the storage engine with a server (Abstract; col. 8, lines 50-66; col. 10, line 26 – col. 11, line 17). Sims discloses a method of unlocking locked content stored

in a storage medium including the steps of authenticating a host device (col. 5, lines 39-59; col. 19, lines 29-49) and authenticating the storage engine with a server (col. 17, lines 1-23). It would have been obvious to modify the Braitberg method to authenticate the host device and authenticate the storage engine with a server, as taught by Sims, in order to verify that the host device and the storage engine are both authorized devices.

10. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Braitberg in view of Sims as applied to claim 24 above, and further in view of Menezes et al ("Handbook of Applied Cryptography"). Sims discloses authenticating the host device requiring two passes (i.e., two messages to be transmitted), but Sims does not disclose using one-pass protocol in which a first entity who generates the random session key is also the entity that encrypts the session key with a second entity's public key and transmits the encrypted session key to the second entity participating in a communication session. Menezes discloses using one-pass protocol for transporting a session key and for implicit key authentication (Section 12.5.1, page 507-508). It would have been obvious to modify the combined method of Braitberg and Sims to authenticate the host device using one-pass protocol, as taught by Menezes, in order to reduce network traffic.

### ***Double Patenting***

11. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory

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obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

12. Claim 25 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 9 of U.S. Patent No. 6,636,966 in view of *Sims, III* (6,550,011). Claim 9 of the patent '966 discloses the same limitations as claim 24 of the present application with two exceptions: (a) authenticating a host device; and (b) receiving a request from the host device at the storage engine to unlock the locked file.

*Sims* discloses a method of unlocking locked content stored in a storage medium including the step of authenticating a host device (col. 5, lines 39-59; col. 19, lines 29-49). It would have been obvious to modify the method of claim 9 ('966) to include the step of authenticating a host device, as taught by *Sims*, in order to verify that the host device is an authorized device.

Although claim 9 of patent '966 does not disclose receiving a request from the host device at the storage engine to unlock the locked file, this step is deemed to be

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inherent because it is the storage engine that communicates with the key server regarding the content key to unlock a certain file when the host device simply serves as a conduit for passing the messages between the storage engine and the key server (col. 6, lines 40-61).

### ***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Braitberg et al., WO 01/54410 A2, discloses a content distribution method and apparatus.

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of



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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh Dinh whose telephone number is 571-272-3802. The examiner can normally be reached on Mon-Fri: 10:00am-6:30pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mp

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Examiner  
Art Unit 2132

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11/26/05

  
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